REMARKS

35 USC 101

Claims 23-25 and 27-31 are rejected under 35 USC 101 for being directed to non-statutory matter. Applicants thank the Examiner for providing suggestions for overcoming the rejection and amend the specification as she suggests.

35 USC 103(a)

Claims 7-9, 11-25, and 27-31 are rejected under 35 USC 103(a) as being unpatentable over Schoen (US Pub. No. 2003/0204720) in view of Creighton (US Pub. No. 2002/0032665). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness of a claimed invention, all the claimed features must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The Examiner has failed to establish a *prima facie* case that either Schoen or Creighton teach or suggest the following features:

Messaging Server Temporarily Storing Digital Certificate As Long As the Associated Instant Messaging Module Remains Logged-in to the Messaging Server

Independent Claims 7 and 23 recite the feature of a messaging server that temporarily stores the digital certificate as long as the associated instant messaging module is logged-in to the messaging server. The certificate is temporarily stored in association with the subscriber device's session to conserve storage space. See, for example, page 15 of the specification. Furthermore, Applicants amend Claims 7 and 23 to emphasize that once the instant messaging session for a particular subscriber device ends, the messaging server removes the digital certificate from the publication record.

The Examiner Asserts that Schoen discloses a messaging server that temporarily stores a digital certificate as long as the associated instant messaging module remains logged-in to the messaging server in paragraph 74. However, paragraph 74 only describes publishing and storing the policy certificate. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). There is no mention in Schoen of removing the

certificate from the database. Furthermore, there is absolutely nothing that even hints at the existence of the policy certificate being contingent upon a subscriber device being logged-in with a server for an instant messaging session.

Furthermore, the public key infrastructure (PKI) in Schoen is a "conventional public key infrastructures." [0033] Thus, the PKI only performs conventional operations such as "public key-based encryption, public key-based decryption, time stamping operations, public key-based digital signatures, and public key-based verification of such digital signatures." [0033] Conventional PKIs are not designed to remove public certificates from the database in response to a subscriber device logging off. Thus, Schoen cannot disclose this feature.

Creighton also fails to disclose this feature. In Creighton, a digital certificate is only revoked when user manually requests that the certification authority revoke the certificate. [0041] Thus, in addition to failing to teach or suggest subscriber devices that are logged into an instant messaging server, Creighton fails to even mention an automatic process for revoking a digital certificate.

Identifying Other Logged-in Subscriber Devices that Previously Designated the Particular Subscriber Device and Notifying the Identified Devices of the Digital Certificate Withdrawn from Use
The Examiner acknowledges that Schoen fails to recite these features. However, the Examiner asserts that Creighton discloses these features in paragraph 42. Applicants respectfully traverse.

Creighton discloses a system and method for enabling a business owner to use an independent party, *i.e.* a certification authority for authenticating and authorizing unknown business partners to have access to online information such as financial information. [0011]

Creighton fails to teach or disclose an instant messaging server, subscriber devices, or any mechanism for determining whether a subscriber device is online. Thus, Creighton cannot possibly teach or disclose the feature of identifying other logged-in subscriber

devices because accessing a webpage is not equivalent to logging into a server using a subscriber device.

Creighton fails to teach or disclose a particular subscriber device's request to unpublish its digital certificate. Creighton merely discloses a business owner's request to revoke a digital certificate issued to a business partner, *i.e.* another party. This is vastly different from an individual requesting that its own digital certificate be removed.

Creighton fails to teach or disclose notifying identified devices of the digital certificate withdrawn from use. The Examiner asserts that paragraph 42 discloses this feature because after the certification authority removes the digital certificate from its database, the certification authority sends an update to the business owner so that the business owner can remove the digital certificate from its own database. This interpretation, however, fails to recognize the significance of the term "other." In this example, the business owner initiated the request for removing the digital certificate. Thus, the business owner is not another subscriber device. Creighton makes no mention of notifying anyone other than the business owner that the digital certificate was withdrawn from use. As a result, Creighton fails to teach or disclose these features.

Teaching, Suggestion, or Motivation to Combine
Even if the combination of Schoen and Creighton disclosed each and every feature of the claimed invention, there is no motivation to combine the references because Creighton teaches away from combining it with Schoen. "When the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. at ___, 82 USPQ2d at 1395 (2007).

Schoen discloses an instant messaging system that uses a conventional PKI for restricting communications between subscriber devices. Any changes in the state of the policy certificate are published to a repository or broadcast to subscribers. [0074]

Creighton discloses a system for third parties to access private information on a website that requires a digital certificate. If the third party's digital certificate is revoked, the third party no longer has access to the website. Thus, Creighton teaches away from being

combined with Schoen because Creighton uses the digital certificate for a completely different application, *i.e.* website access and has no need to identify subscriber devices because access is already blocked with revocation of the digital certificate. In addition, subscriber devices are not accessing the information.

Conversely, Schoen teaches away from being combined with Creighton because Schoen already teaches broadcasting a notice of a change in the policy certificate to subscribers. Combining Creighton with Schoen adds nothing to Schoen.

In summary, because Schoen and Creighton fail to teach or suggest temporarily storing the submitted digital certificate, automatically removing the submitted digital certificate from the publication record once the subscriber device ends the session, a request by a subscriber device to un-publish its own digital certificate, identifying other logged-in subscriber devices, and notifying identified devices of a digital certificate withdrawn from use, the Examiner has failed to make a *prima facie* case of obviousness.

Because Claims 8, 9, 11-22, 24, 25, and 27-31 depend upon either Claim 7 or 23, they are patentable for at least the same reasons as Claims 7 and 23.

Conclusion

Applicants respectfully posit that the pending claims have been distinguished from the art of record, and that the rejection of the claims has been overcome. Accordingly, Applicants respectfully request allowance of all claims. The Examiner is invited to please contact Applicants' attorney at (650) 474-8400 should any questions arise.

Respectfully submitted,

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